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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,459	10/22/2003	Ajay R. Bam	65003/P002US/10312242	7339

29053 7590 05/29/2009
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ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
05/29/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/691,459	BAM ET AL.	
	Examiner	Art Unit	
	KHANH H. LE	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-14,16-22,26-41,44-50,52-63 and 65-73* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-14,16-22,26-41,44-50,52-63 and 65-73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2008-12-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the correspondence filed February 17, 2009. Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63, 65 and 66-73 were pending with claims 74-75 withdrawn. No claims are added nor cancelled. Thus claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63, 65-73 are pending and herein examined. Claims 26, 30, 70 are amended.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

a) Claims 66-69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 66 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter: the claim deals with a system for redeeming promotions comprising a server and means for conducting the method steps.

Since a server can be software (see e.g. definition "A server is the computer program (housed in a computer) that serves requested HTML pages or files by the client" from www.soft.com/eValid/Products/Documentation.7/Technical/definitions.html , downloaded on 10/14/08 from http://www.google.com/search?sourceid=navclient&aq=t&ie=UTF-8&rls=GGLD,GGLD:2004-30,GGLD:en&q=define%3a+server), and the means can also be software, the claim does not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition.

Dependent Claims 67-69 suffer from the same defects.

b) Response to arguments:

Applicants argue claims 66-69 are statutory under 35 U.S.C. § 101. Applicants argue that the Examiner has not cited any limitations from the specification that mandates the recited means in those claims to be merely software per se." Applicant agrees however, the application describes "that to the extent that the recited means elements may be implemented as software, such software may be stored in a tangible computer readable storage medium" (underline emphasis added). This means the means can be software and this also means when the software may or may not be stored in a tangible computer readable storage medium. Thus the software can be software per se. If the claims read on both software per se and software on a tangible computer readable storage medium, (i.e. as a matter of claim interpretation, if the scope of a claim encompasses both on a non-statutory embodiment and a statutory embodiment) a rejection under 35 U.S.C. § 101 is proper. Here, Applicant has not narrowed down the claim to read only on a statutory embodiment.

c) Claims 1, 13, 22, 26, 30, 37, 49, 70 and their dependents are considered statutory:

Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of

the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

Here, the method claims are considered to be directed to statutory subject matter because the steps are deemed tied to another statutory class of invention (such as a particular apparatus, e.g. implied "wireless" means) not in a nominal way since one of the main goals of the application is direct wireless transmission to consumers.

d) Claims 41, 55, 61 and their dependents are considered statutory because not all claimed elements can be considered software, e.g. a "wireless mobile electronic device" or "mobile electronic device" is clearly apparatus, such as a PDA or cell phone.

Interpretation

3. Claims 55, 56, 59:

Applicant appears to invoke 35 USC §112-6th paragraph by (1) utilizing the phrase "means for", (2) modified by functional language, (3) without an indication of sufficient structure, materials, or acts, in the claim, to achieve those functions. In this vein, Claims 55, 56, and 59 would ordinarily be construed to cover the corresponding structure, material or acts disclosed in the specification and equivalents thereof. However, Applicant's specification does not describe any explicit structure, material or acts as associated with each particular "means for" clause of the claims. This raises an ambiguity issue (e.g. what "means" in particular accomplishes the functional limitation). ["[S]tructure disclosed in the specification is *corresponding* structure *only if the specification or prosecution history clearly links or associates that structure to the function* recited in the claim. This duty to link or associate structure to

function is the quid pro quo for the convenience of employing 112, paragraph 6." (emphasis added) & "If no definition (e.g. link) is provided, some judgment must be exercised in determining the scope of the limitation." (see MPEP 2182, parenthetical added)]. As such, without a direct link, Examiner will interpret all claim limitations as reading on any prior art means which is capable of performing the specified functions under a broadest reasonable interpretation.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63, 65 and 66-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan et al (6,237,145) in view of Official Notice (with e.g. Aggarwal US 7013286 B1 as support thereof) and/or legal precedent.

Claims 1, 3, 26, 30, 37, 55, 61, and 62:

Narasimhan discloses a system, device, and method for distributing promotions, comprising:

a. generating a promotion for use by a specific consumer (column 3, lines 28-35);

b. transmitting the promotion data to a mobile electronic device of a requesting consumer (column 4, lines 16-20 and column 7, lines 10-49); and

c. applying the promotion to a purchase using the mobile electronic device (column 7, line 50 – column 8, line 3).

As discussed in the rejection of Claim 6, 15, 24, and 43 in the December 7, 2007 Office Action, Narasimhan discloses the electronic device is a mobile device (smart card) (column 7, lines 10-49).

The Applicant has argued that the promotion is not transmitted to the smart card nor that a response is received from the smart card; thus, "the smart card is merely an identification card for the user and not a mobile electronic device".

However Examiner J. Myhre had noted that Narasimhan explicitly discloses that the user may "employ a smart card reader/writer 128 to store the clipped electronic coupons in an appropriately configured clipped coupon database 118 on the smart card" and that subsequently the merchant device 122 can "read the clipped electronic coupons from the database 118 on the smart card" (column 7, lines 10-48). Thus, the promotion data (coupons) is being transmitted (and stored) onto the smart card and the merchant device is receiving a response from the smart card when querying the clipped coupon database to retrieve the promotion information (coupon). Therefore, the smart card is performing the functions of the claimed "mobile electronic device".

Furthermore, as discussed in previous (and current) rejections of Claims 64 and/or 65, it would have been obvious that any type of device with the appropriate input, output, and storage mechanisms could be used, to include a credit card type of smart card (such as the one disclosed by Narasimhan), a cell phone, a personal data assistant (PDA), a pager, etc. One would have been motivated to incorporate the functionality and storage of the smart card into other mobile devices, such as a cell phone, in order to eliminate the need to carry multiple mobile devices (e.g. a smart card, a cell phone, AND a pager).

It appears Applicants argue Narasimhan's portable card device (which can be a magnetic stripe card, or smart card or IC card, col. 7 lines 20-32) with its card reader to download coupons to the card is not a wireless device and wireless transmission of data to the wireless device and wirelessly applying the promotion using the mobile electronic device arguably is not disclosed in Narasimhan.

Even if such is conceded, the following references, evidencing the level of skill in the art at the time of the invention, are provided as support for the above reasoning or Official Noticed facts taken earlier by Examiner Myhre.

It is known at the time of invention that the following types of user devices or terminals, wired or mobile or wireless, can all be used interchangeably to receive/transfer data including incentives or coupons data.

For example,

Kolls US 6601040 in e-commerce/coupons scheme discloses interchanging smart card reader/writers with magnetic card reader/writers and other devices including wireless devices and networks (col. 14 lines 25-29; 40-49) to access/transfer data;

Freeman US 6450407 B1 discloses rebates or discounts are downloaded to a customer's chip card via a multiplicity of possible channels including: a personal computer, a portable chip card reader, a point-of-sale (POS) terminal, a handheld device, a home or business telephone, a vending machine, a cellular phone, a pager, a mass transportation payment station, a television and/or television set-top box, or an automated teller machine (ATM) (abstract) and cell phones with chip card communication ports (col. 8 lines 23-31);

Aggarwal US 7013286 B1 in a generation, distribution, storage, redemption, validation and clearing of electronic coupons scheme (abstract), discloses at (col.10 lines 13-22):

"In another embodiment, the customer obtains electronic coupons and at a later stage, he or she downloads the electronic coupon in a portable device such as floppy disk, magnetic tape, compact disk, personal digital assistant, portable smart-card, cellular phone, etc., and takes the portable device to a retailer where the coupon verification equipment reads the electronic coupon from the portable device either using a wired communication channel or a wireless channel. The verification equipment then checks the validity of the coupon. If the coupon is valid, the retailer gives the intended discount to

the customer."

Further it is a trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems.

Leapfrog v. Fisher-Price (Fed. Cir. 2007) affirming a finding of obviousness, had addressed the issue of adoption of trends in the art, which is relevant in our case.

(This is the first application of the Supreme Court's obviousness pronouncement in *KSR v. Teleflex* by the Court of Appeals for the Federal Circuit (CAFC))

Leapfrog and Fisher-Price compete in the toy market. In this case, Leapfrog sued Fisher-Price -- alleging that Fisher-Price's PowerTouch Learning System infringes claim 35 of Leapfrog's patent.

The trial court found the patent not-infringed and **invalid as obvious.** On appeal, the CAFC affirmed, noting that the **obviousness analysis requires a common sense approach rather than any rigid formula**.

The CAFC held:

"An obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. See KSR Int'l Co. v. Teleflex Inc., *550 U.S. __ (2007)*

("The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

This case has serious and direct implication for the instant application. The two pieces of prior art in Leapfrog were Bevin (electro-mechanical, but not electronic, toy for phonetic learning) and SSR (electronic book-type toy). Together, the two references teach almost all the elements of the asserted claim, and the courts found their combination to be appropriate.

The Court further held (emphasis added):

We agree with the district court that one of ordinary skill in the art of children's learning toys would have found it ***obvious to combine*** *the Bevan* ***device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost.*** *While the SSR only permits generation of a sound corresponding to the first letter of a word, it does so using electronic means.* ***The combination is thus the adaptation of an old idea or invention (Bevan) using newer technology that is commonly available and understood in the art (the SSR).*** *We therefore also find no clear error in the finding of the district court that* ***one of ordinary skill in the art could have utilized the electronics of the SSR device, with the method of operation taught by Bevan, to allow*** *a child to press each individual letter in a word and hear the individual phonemes associated with each letter to sound out the words.*

The one remaining limitation -- a "reader" -- was "well-known in the art at the time of the invention" and its combination. That known element could be combined because it provides "an added benefit and simplified use of the *toy for the child* ***in order to increase its marketability."***

....Leapfrog presents no evidence that the inclusion of a reader in this type of device ***was uniquely challenging or difficult for one of ordinary skill in the art.*** *Nor does Leapfrog present any evidence that* ***the inclusion of a device commonly used in the field of electronics (a reader), and even in the narrower art of electronic children's toys, represented an unobvious step over the prior art.")***

Here, replacing the unit of Narasimhan with a cell phone or PDA is the adaptation of an old idea or invention (Narasimhan) using newer technology that is commonly available and understood in the art (the cellphone or PDA). As reasoned in Leapfrog, one of ordinary skill in the art could have utilized the electronics of the cellphone or PDA, with the method of operation taught by Narasimhan, to allow the user *an added benefit such as* convenience or mobility in the use of the promotion system taught by Narasimhan thereby increasing its appeal or marketability to the user. There is no evidence the combination is uniquely challenging or difficult for one of ordinary skill in the art thus the combination is obvious.

In view of the interchangeability of user devices as has been done in the prior art discussed above, and/or in view of the legal precedent of Leapfrog as discussed above, it would have been obvious to a person having ordinary skill in the art at the time the invention was made

(herein a "PHOSITA") to replace **the unit including the card interface of Narasimhan with a cell phone with chip card communication ports as taught by Freeman or with a portable phone as taught in Aggarwal.**

In case a portable phone is used, a wireless mobile communication network interface and means configured to communicate via a wireless mobile communication network with a service facility that provides the service as substantially claimed will be used, such as taught by Aggarwal (citation above), to allow the user the benefit of convenience or mobility in the use of the promotion system taught by Narasimhan thereby increasing its appeal or marketability to the user.

The Applicants argue in reference to Claim 1 that the step of "wirelessly applying said promotion to a purchase using said mobile electronic device" is not disclosed. However, as discussed in the rejection above, and in the rejection of Claim 6, 15, 24, and 43 in the December 7, 2007 Office Action, Narasimhan discloses the electronic device is a mobile device (smart card) (column 7, lines 10-49). The Examiner further notes that Narasimhan explicitly discloses that the user may "employ a smart card reader/writer 128 to store the clipped electronic coupons in an appropriately configured clipped coupon database 118 on the smart card" and that subsequently the merchant device 122 can "read the clipped electronic coupons from the database 118 on the smart card" (column 7, lines 10-48). Thus, the promotion data (coupons) is being transmitted (and stored) onto the smart card and the merchant device is receiving a response from the smart card when querying the clipped coupon database to retrieve the

promotion information (coupon). Therefore, the smart card is performing the functions of the claimed "mobile electronic device".

Furthermore, as discussed in previous (and current) rejections of Claims 64 and 65, it would have been obvious that any type of device with the appropriate input, output, and storage mechanisms could be used, to include a credit card type of smart card (such as the one disclosed by Narasimhan), a cell phone, a personal data assistant (PDA), a pager, etc. One would have been motivated to incorporate the functionality and storage of the smart card into other mobile devices, such as a cell phone, in order to eliminate the need to carry multiple mobile devices (e.g. a smart card, a cell phone, AND a pager). Further as discussed above, e.g. AGGARWAL supplies the wireless limitation. The rationale for the substitution is as above discussed. Thus, contrary to argument, the combination of Narasimhan in view of e.g. AGGARWAL as above discussed discloses the step of "wirelessly applying said promotion to a purchase using said mobile electronic device" as set forth in claim 1.

The Applicants argue in reference to Claims 26 and 30 that the steps of "generating said promotion for use by a targeted consumer, wherein said targeted consumer is selected from a plurality of potential consumers" as set forth in claim 26, and the step of "generating said promotion for use by a requesting consumer, wherein said requesting consumer is prompted to request said promotion" as set forth in claim 30, are not disclosed.

However Narasimhan explicitly discloses transmitting data relating to the promotion to a mobile electronic device (see discussion above).

Further as to prompting the consumer to request the promotion, Narasimhan discloses the consumer requests the promotional data by logging in and walking through the hierarchical tree to select the desired promotional data (coupons) which are then stored in the database on the smart card. Walking through the hierarchical tree reads on the system prompting the user to request the promotion.

The Applicants argue in reference to Claim 37 that "receiving a reply from said mobile electronic device of said targeted consumer in response to said promotional offer; and facilitating a purchase by said targeted consumer, said purchase correlated to said promotional offer" are not disclosed. However the combination of Narasimhan in view of e.g. AGGARWAL does disclose transmitting data relating to the promotion to a mobile device and receiving a reply from the consumer via the mobile electronic device. These arguments have been addressed above. See discussion above.

The Applicants argue in reference to Claim 55 that" a mobile electronic device including at least "means for applying received promotion data when a purchase is made at a point of sale (POS)" is not disclosed. However, this argument has been addressed in reference to Claim 41 below.

The Applicants argue in reference to Claim 61 that "a wireless mobile electronic device associated with a particular consumer; and means for receiving from said wireless mobile electronic device associated with said particular consumer an acceptance of said promotion" is

not disclosed. However, Examiner Myhre had emphasized earlier that the Examiner considers the selection by the consumer, in Narasimhan, of the desired coupons as being an acceptance thereof. As discussed above, the selection may be made through the smart card, cell phone, pager, or other mobile electronic device being used by the consumer. Thus, contrary to argument, the combination of Narasimhan in view of e.g. AGGARWAL as above discussed discloses at least "a wireless mobile electronic device associated with a particular consumer; and means for receiving from said wireless mobile electronic device associated with said particular consumer an acceptance of said promotion" as set forth in claim 61.

Claim 13: Narasimhan discloses a method for redeeming promotions, comprising:

a. accessing a promotion stored on a consumer's mobile electronic device (column 4, lines 16-20 and column 7, lines 10-49);

b. applying (redeeming) the promotion to a purchase (column 7, line 50 – column 8, line 3);

c. receiving a response from the consumer mobile electronic device redeeming the promotion (column 6, lines 30-36 and column 7, lines 10-49); and

d. saving the redemption data in an electronic account (column 6, lines 30-36 and column 7, lines 10-49).

As discussed in the rejection of Claim 6, 15, 24, and 43 in the December 7, 2007 Office Action, Narasimhan discloses the electronic device is a mobile device (smart card) (column 7, lines 10-49). The Applicant has argued that the promotion is not transmitted to the smart card nor that a response is received from the smart card; thus, "the smart card is merely an

identification card for the user and not a mobile electronic device". However, the Examiner notes that Narasimhan explicitly discloses that the user may "employ a smart card reader/writer 128 to store the clipped electronic coupons in an appropriately configured clipped coupon database 118 on the smart card" and that subsequently the merchant device 122 can "read the clipped electronic coupons from the database 118 on the smart card" (column 7, lines 10-48). Thus, the promotion data (coupons) is being transmitted (and stored) onto the smart card and the merchant device is receiving a response from the smart card when querying the clipped coupon database to retrieve the promotion information (coupon). Therefore, the smart card is performing the functions of the claimed "mobile electronic device".

Furthermore, as discussed in previous (and current) rejections of Claims 64 and 65, it would have been obvious that any type of device with the appropriate input, output, and storage mechanisms could be used, to include a credit card type of smart card (such as the one disclosed by Narasimhan), a cell phone, a personal data assistant (PDA), a pager, etc. One would have been motivated to incorporate the functionality and storage of the smart card into other mobile devices, such as a cell phone, in order to eliminate the need to carry multiple mobile devices (e.g. a smart card, a cell phone, AND a pager).

In view of the interchangeability of user devices as has been done in the prior art discussed above, and/or in view of the legal precedent of Leapfrog as discussed above, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the unit including the card interface of Narasimhan with a cell phone with chip card communication ports as taught by Freeman or with a portable phone as taught in Aggarwal.

As discussed above, in case the unit including the card interface of Narasimhan is replaced by a portable phone as taught in Aggarwal (citation above), a wireless mobile communication network interface configured to communicate via a wireless mobile communication network with a service facility that provides the service will be used, such as taught by Aggarwal (citation above), to allow the user the benefit of convenience or mobility in the use of the promotion system taught by Narasimhan thereby increasing its appeal or marketability to the user.

Examiner Myhre had emphasized earlier that, in Narasimhan, the data pertaining to the promotion is being stored on the smart card and that the smart card replies to an inquiry from the merchant device by retrieving (accessing) the promotion (coupon) data from the database when redeeming the promotion and transmitting (replying) the data to the merchant device.

Thus, contrary to argument, the combination of Narasimhan with e.g. Aggarwal as above discussed discloses at least the step of "redeeming said promotion by wirelessly replying to said server using said mobile electronic device" as set forth in claim 13.

Claims 22, 41, and 44:

Narasimhan a system and method for distributing a promotion, comprising:

a. generating promotions for use by a consumer (column 3, lines 28-35);

b. sending the promotion data to a consumer account accessible on the customer's mobile electronic device when requested (column 4, lines 16-20 and column 7, lines 10-49); and

c. saving (storing) the promotion in the consumer account for later access and use by the requesting consumer' mobile electronic device (column 4, lines 16-20 and column 7, lines 10-48).

As discussed in the rejection of Claim 6, 15, 24, and 43 in the December 7, 2007 Office Action, Narasimhan discloses the electronic device is a mobile device (smart card) (column 7, lines 10-49). The Applicant has argued that the promotion is not transmitted to the smart card nor that a response is received from the smart card; thus, "the smart card is merely an identification card for the user and not a mobile electronic device".

However, the Examiner notes that Narasimhan explicitly discloses that the user may "employ a smart card reader/writer 128 to store the clipped electronic coupons in an appropriately configured clipped coupon database 118 on the smart card" and that subsequently the merchant device 122 can "read the clipped electronic coupons from the database 118 on the smart card" (column 7, lines 10-48). Thus, the promotion data (coupons) is being transmitted (and stored) onto the smart card and the merchant device is receiving a response from the smart card when querying the clipped coupon database to retrieve the promotion information (coupon). Therefore, the smart card is performing the functions of the claimed "mobile electronic device".

Furthermore, as discussed in previous (and current) rejections of Claims 64 and 65, it would have been obvious that any type of device with the appropriate input, output, and storage mechanisms could be used, to include a credit card type of smart card (such as the one disclosed

by Narasimhan), a cell phone, a personal data assistant (PDA), a pager, etc. One would have been motivated to incorporate the functionality and storage of the smart card into other mobile devices, such as a cell phone, in order to eliminate the need to carry multiple mobile devices (e.g. a smart card, a cell phone, AND a pager).

Examiner Myhre had emphasized earlier that, in Narasimhan, it is explicitly disclosed that the promotions are stored (saved) in a database (account) "on the smart card" (i.e. "on the mobile electronic device"). Such a database would inherently be accessible by the smart card when redeeming the coupon at the merchant device as discussed above.

Thus, contrary to argument, the combination of Narasimhan in view of e.g. AGGARWAL (support for the Official Notice) as above discussed discloses at least the step of "saving said promotion in a promotion saving account accessible by said mobile electronic device wherein said consumer wirelessly redeems said promotion using said mobile electronic device for a purchase at a point of sale (POS)" as set forth in claim 22.

The Applicants argue in reference to Claim 41 that at least the limitation of "a mobile electronic device operable for wirelessly transmitting a request for promotional data and for wirelessly receiving generated promotion data" is not disclosed. However, as noted by Examiner Myhre in the last Office Action (pages 13-18)" Narasimhan discloses the consumer requests the promotional data by logging in and walking through the hierarchical tree to select the desired promotional data (coupons) which are then stored in the database on the smart card. Since

Narasimhan's smart card has at least one input means and at least output means (in order to receive and send the promotional data to and from the database), it is inherently capable of transmitting the request through its output means and receiving the promotional data through its input means. Furthermore, as discussed in the rejection above, it would have been obvious that any type of device with the appropriate input, output, and storage mechanisms could be used, to include a credit card type of smart card (such as the one disclosed by Narasimhan), a cell phone, a personal data assistant (PDA), a pager, etc. One would have been motivated to incorporate the functionality and storage of the smart card into other mobile devices, such as a cell phone, in order to eliminate the need to carry multiple mobile devices (e.g. a smart card, a cell phone, AND a pager). As stated above, AGGARWAL supplies support for the Official Notice taken by Examiner Myhre thus the claim limitation(s) is (are) met.

Claims 49 and 52-54:

Narasimhan discloses a method for distributing a promotion, comprising:

a. generating a promotion based on accessing a consumer profile database that includes consumer buying habits (column 4, lines 41-49);

b. transmitting the promotion data to a mobile electronic device of a requesting consumer (column 4, lines 16-20 and column 7, lines 10-49); and

c. applying (redeeming) the promotion to a purchase using the mobile electronic device (column 7, line 50 - column 8, line 3).

As discussed in the rejection of Claim 6, 15, 24, and 43 in the December 7, 2007 Office Action, Narasimhan the electronic device is a mobile device (smart card) (column 7, lines 10-49). The Applicant has argued that the promotion is not transmitted to the smart card nor that a response is received from the smart card; thus, "the smart card is merely an identification card for the user and not a mobile electronic device". However, the Examiner notes that Narasimhan explicitly discloses that the user may "employ a smart card reader/writer 128 to store the clipped electronic coupons in an appropriately configured clipped coupon database 118 on the smart card" and that subsequently the merchant device 122 can "read the clipped electronic coupons from the database 118 on the smart card" (column 7, lines 10-48). Thus, the promotion data (coupons) is being transmitted (and stored) onto the smart card and the merchant device is receiving a response from the smart card when querying the clipped coupon database to retrieve the promotion information (coupon). Therefore, the smart card is performing the functions of the claimed "mobile electronic device".

Furthermore, as discussed in previous (and current) rejections of Claims 64 and 65, it would have been obvious that any type of device with the appropriate input, output, and storage mechanisms could be used, to include a credit card type of smart card (such as the one disclosed by Narasimhan), a cell phone, a personal data assistant (PDA), a pager, etc. One would have been motivated to incorporate the functionality and storage of the smart card into other mobile devices, such as a cell phone, in order to eliminate the need to carry multiple mobile devices (e.g. a smart card, a cell phone, AND a pager). As stated above, AGGARWAL supplies support for the Official Notice taken by Examiner Myhre thus the claim limitation(s) is (are) met.

The Applicants argue the step of "matching said promotion with a merchant profile in a merchant profile database when said consumer redeems said promotion by wirelessly communicating using said mobile electronic device in an electronic purchase" as set forth in claim 49.

Examiner Myhre had emphasized earlier that, in Narasimhan, the promotion is stored on the smart card; thus, it is transmitted to the mobile electronic device. "The promotional data is also matched against merchant data (transaction data) to ensure the corresponding product is being purchased at the correct merchant before redeeming the coupon. Since there is no other mention or use of the merchant profile in the claims, the Examiner has interpreted the matching step as to ensuring that the merchant is an authorized merchant for redemption of the promotional item (coupon) as is common in the art when the coupon is a merchant-specific coupon."

Further as discussed above AGGARWAL teaches substitution into a cellular phone if desired. Thus, contrary to argument, the combination of Narasimhan in view of e.g. AGGARWAL as above discussed discloses at least the step of "matching said promotion with a merchant profile in a merchant profile database when said consumer redeems said promotion by wirelessly communicating using said mobile electronic device in an electronic purchase" as set forth in claim 49.

Claims 66-69 and 70-73:

The elements in these claims that are common to claims 49 and 52-54, or 1, 37, or 61-63 are rejected as above discussed with reference to those claims.

The elements in these claims that are common to claims 4 and/or 13 are rejected as discussed below or above with reference to claims 4, and/or13.

The Applicants argue in reference to Claim 70 that at least the step of "accepting over a temporarily established communication connection from a wireless mobile electronic device of any one of a plurality of users information specific to one of many merchants, said information including data specific to a unique location of one of said merchants, said specific data pertaining to merchandise obtained from said merchant" as set forth in claim 70 is not disclosed. This is interpreted as the Applicants argue that Narasimhan does not disclose the user specifying a merchant and receiving promotional information pertaining to that merchant in a wireless mobile electronic device environment.

However, it is disclosed in Narasimhan that the consumer accesses the promotional database, walks down through the hierarchical tree to a desired promotion or promotional area, and selects the desired promotion. In the coupon arts there are two types of coupons - - general coupons which may be redeemed at any merchant that carries the product (e.g. a manufacturer's coupon) and specific coupons which may only be redeemed at one or more specific merchants (e.g. a Giant Foods coupon redeemable at a specific, or any, Giant Foods supermarket). Thus, it

is inherent that when the customer in Narasimhan traverses the tree to the desired promotional area, the selected promotional area may be a specific merchant, such as for JC Pennies ®.

Thus, contrary to argument, the combination of Narasimhan in view of e.g. AGGARWAL as above discussed discloses the above claimed limitation as set forth in claim 70.

Claims 2, 14, and 50: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a method as in Claims 1, 13, and 49 above, and Narasimhan further discloses the promotion is a coupon, a discount, an alert, or an offer to sell (column 3, lines 28-35).

Claim 4: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a method as in Claim 3 above, and Narasimhan further discloses processing the redemption (inherently, according to established redemption rules) (column 7, lines 10-49).

Claims 5, 18, 36, 46, and 56: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a system, device, and method as in Claims 1, 13, 30, 41, and 55 above, and Narasimhan further discloses storing the promotion in an electronic account for later access by the consumer (column 4, lines 16-20 and column 7, lines 10-49).

Claims 7, 8, and 21: Narasimhan in view of Official Notice and/or legal precedent as above discussed discloses a method as in Claims 1 and 13 above, and Narasimhan further discloses the transmitted data (promotion) is a text or audio (voice) message (column 3, lines 28-35).

Claims 9, 16, and 33-35: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a method as in Claims 1, 13, and 30 above, and Narasimhan further discloses a promotion distributor generating the promotion based on a request from the consumer (column 3, lines 10-16 and column 8, lines 5-7).

Claims 10, 17, 27-29, 38-40, and 45: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a system and method as in Claims 1, 13, 26, 37, and 41 above, and Narasimhan further discloses generating the promotion based on the stored profile of the consumer/merchant (column 4, lines 41-49).

Claim 11: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a method as in Claim 1 above, and Narasimhan further discloses automatically applying the promotion during the purchase transaction (column 7, lines 10-49).

Claims 12 and 57: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a device and method as in Claims 1 and 55 above, and Narasimhan further discloses identifying the consumer by identifying the electronic device (smart card) (column 7, lines 10-49).

Claims 19 and 63: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a system and method as in Claims 13 and 62 above, and Narasimhan further discloses redeeming the promotion at a point of sale (POS) terminal (merchant device) using a payment method controlled by the consumer's mobile electronic device (credit card) (column 7, lines 10-60).

Claim 20: Narasimhan in view of Official Notice and/or legal precedent as above discussed discloses a method as in Claims 1 or 19 above, and Narasimhan further discloses automatically applying the promotion during the purchase transaction (column 7, lines 10-49).

Claims 31 and 32: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a method as in Claim 30 above, and Narasimhan further discloses that notifying consumers of promotions through the use of various types of advertisements (newspapers, television, etc.) was known well before the present invention (column 1, lines 23-55). Furthermore, no patentable weight is given as to why the consumer is requesting the promotion.

Claims 12, 47, 48, and 57-60: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a method, system and device as in Claims 1, 41 and 55 above, and Narasimhan further discloses utilizing an Internet or telephone interface (column 4, lines 9-15). In addition, Aggarwal as support for the Official Notice discloses cell phones (citation above).

Thus Narasimhan in view of Official Notice (e.g. Aggarwal) and/ or legal precedent as above discussed discloses the claimed promotion communication means. It is noted little if any patentable weight can be given to the type of protocol technology being used by these communication systems. Official Notice is taken that communication systems protocols such as DTMF for telephones, XML or J2EE for computer networks (including the Internet), etc. are well-known before invention time, thus it would have been obvious to one having ordinary skill in the art at the time of the invention to add the appropriate compatible ones to the system of Narasimhan in view of Official Notice and/ or legal precedent as above discussed, based on the capabilities of the specific hardware and software being used by the communication system to allow compatible functioning.(Further it is noted the type of protocol being used would not affect, nor has the Applicant pointed out how any of them would affect, the steps being performed).

Claim 65: Narasimhan in view of Official Notice and/ or legal precedent as above discussed discloses a system as in Claim 61 above, but does not explicitly disclose that the consumer device is a wireless device, such as a cell phone. However, it is noted that there are

two ways for entering and retrieving data from smart cards, such as the ones disclosed in Narasimhan. The first is electronic contacts in which one or more contacts must be brought into physical contact with corresponding contacts on a card reader. The second is wireless contacts in which infrared, light, or radio waves are used to transfer the data with no physical contact between the smart card and the card reader. Each contact method has its known advantages and disadvantages. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Narasimhan could use a contact or contactless device for the consumer's device. Furthermore, it would have been obvious that any type of device with the appropriate input, output, and storage mechanisms could be used to include a credit card type of smart card, a cell phone, a personal data assistant (PDA), a pager, etc. One would have been motivated to use a wireless device, such as a cell phone, in order to eliminate the need for the customer to carry an additional device by combining multiple functions into one device. The Examiner further notes that little if any patentable weight is given to the type of other functions the device is able to perform, i.e. as to whether the device can also make telephone calls, access the Internet, play music, etc., since none of these other functions are being used in the claimed invention.

Further as discussed above, e.g. AGGARWAL (support for the Official Notice) teaches substitution into a cellular phone if desired. Thus, contrary to argument, the combination of Narasimhan in view of e.g. AGGARWAL as above discussed discloses all of claim 65.

Response to Arguments

6. Applicant's arguments filed **February 17, 2009** have been fully considered but they are not persuasive.

Applicants argue Official Notice was not taken by Examiner Myhre. It is noted statements like " it is known before invention time" are equivalents to Official Notice. It is noted several references were provided in support of such statements.

Applicants seem to repeat the argument that the smart card of Narasimhan is not a wireless device. As stated earlier and above even if such is conceded, this is a rejection under 35 U.S.C. 103 and several references had been provided in support of the Official Notice, e.g. Aggarwal (excerpted above). Applicants argue that it would not have been obvious to replace the unit including the card interface of Narasimhan with a cell phone with chip card communications port as taught by Freeman or with a portable phone as taught in Aggarwal as the last Office Action suggests at 9-10. This flies in the face of at least Aggarwal which clearly shows the interchangeability of the several mobile devices to transfer promotion-related data, including using cellphones which clearly are wireless devices. See excerpt of Aggarwal above. As to Applicant's challenge to Leapfrog, Aggarwal is clear evidence of the Examiner's assertion of the "trend in the art for everybody to go mobile and do things on cellular phones/PDAs and the likes that used to be done in wired systems." See e.g. excerpt of Aggarwal.

Challenges to claim Rejections under 35 USC § 101 are addressed in the rejection discussion above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner can normally be reached on Monday-Wednesday 9:00-6:00. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For

patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314). Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh H. Le/
Examiner, Art Unit 3688
May 25, 2009

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688